

REMARKS

Claims 1-19 are pending in the present application. New claims 24-27 have been added by this Amendment, leaving claims 1-19 and 24-27 pending for consideration upon entry of the present amendment. Reconsideration of the rejection of the claims is respectfully requested.

Claim Rejections

Claims 1-19 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Applicants' admission either individually, or in view of U.S. Patent No. 3,839,078 to Birchall et al. ("Birchall"). In particular, the Examiner reiterates that "Birchall teaches that it has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate readily adheres often referred to as 'anchor' coatings", such that "it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior art with an anchor layer"

In the Advisory Action accompanying the Amendment After Final submitted on July 7, 2003, the Examiner expanded on this rejection, further stating:

Birchall expressly teaches that it has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate readily adheres. Such intermediate coating layers are often referred to as "anchor" coatings and are derived, for example, from an isocyanate-ended polyurethane resin, a phenol-formaldehyde resin or a vinylidene chloride-alkyl acrylate copolymer resin (column 22, lines 5-14). As such, since Birchall teaches all the elements of the "anchor" layer of the instantly claimed invention, it is believed that the improved cohesive strength in the surface region of the substrate by the "anchor" layer is also inherently disclosed by [Birchall]. It should be recognized that latent properties in the prior art does not render nonobvious an otherwise known invention.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully request reconsideration of this rejection, as the instant specification and Birchall fail to provide a motivation to use an anchoring layer between the claimed polyurethane foam and composite reinforcing film in a foam cushion tape, and fail to provide any expectation of success in so doing. Even if the specification and Birchall could be said to make the claims *prima facie* obvious, Applicants have shown surprising results that rebut such case.

Applicants agree that Birchall teaches use of an intermediate adhesion promoting layer between a film substrate and a superstrate. Such layers are used when the adhesion between the substrate and the superstrate are insufficient. As stated by Birchall:

For many applications of films it is desirable to provide a film substrate with a superstrate of another material. . . . However, it is difficult to develop sufficient adhesion between the film substrate and superstrate which will be maintained during subsequent processing and usage of the film.

(Birchall, col. 21, line 61 to col. 22, line 4.)

This is in distinct contrast to the present case. As stated in the specification, and shown in the Declaration, failure of the claimed foam cushion tapes upon removal from a drum is not due to insufficient adhesion between the polyurethane foam and the composite reinforcing layer. It is due, instead, to weak cohesive strength at the surface of the reinforcing layer itself. In other words, the bond between the polyurethane foam and the reinforcing layers is so strong that when a foam cushion tape is removed from a drum, the reinforcing layer fails before the bond fails. From a practical standpoint, this failure can lead to many hours of lost time during the printing process.

Given that the problem to be solved was failure of the reinforcing film, and not the strength of the bond between the reinforcing film and the polyurethane foam, use of an anchoring layer between the film and the foam is unobvious. The inventors simply had no motivation to use an "adhesion promoting" layer where the apparent problem was the strength of the one of the layers to be adhered.

The inventors certainly had no expectation of success in so doing. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Birchall discloses that anchoring layers can be used as adhesion promoting layers between a film substrate and a superstrate that do not have "sufficient adhesion". The problem to be solved by the invention was not insufficient adhesion, but insufficient cohesive strength of the film layer when used in combination with a foam. There is no reason to expect that use of an anchoring layer would improve the apparent cohesive strength of the reinforcing film. This is particularly so based on Birchall's teaching that anchoring layers are commonly used in connection with "organic plastics

films” and not polyurethane foams as is presently claimed. Birchall further fails to disclose the specific materials required in claims 20 and 22, for example. The specification and Birchall therefore do not provide any motivation to make the suggested combination, and no expectation of success if such combination were made.

For these same reasons, use of an anchoring layer as disclosed and claimed provides unexpected results. Here, the inventors found that delamination between a polyurethane foam and a reinforcing layer is due to the properties of the reinforcing layer in combination with a foam, rather than the bond between the layers. It is therefore unexpected that the presence of a layer used to improve bond would prevent delamination. The Examiner appears to dismiss these results on the basis of inherency, stating “it is believed that the improved cohesive strength in the surface region of the substrate by the ‘anchor’ layer is also inherently disclosed by [Birchall].”

Applicants respectfully suggest that such results cannot be inherent in Birchall. An inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). A finding of inherency cannot be made where it flows as simply a possible conclusion from the teachings of the prior art. Birchall merely teaches that the disclosed anchoring layers can be used to improve adhesion between “organic plastics films”, such as those used in packaging or as a photographic film base, together with “superstrates” such as a heat-sealable coating (col. 21, lines 59-68). The Examiner has provided no technical or factual grounds for any assertion that use of an adhesion promoting layer with the substrates and superstrates of Birchall would necessarily result in improved cohesive strength at the surface of one of the layers. The improved results are therefore not inherent in Birchall, and Applicants respectfully request reversal of the rejection and allowance of claims 1-19 and 24-27.

New Claims

New claims 24-27 have been added to further clarify the invention, and are allowable as depending from allowable independent claims. Antecedent basis for the amendments is found, for example, at Table 1.

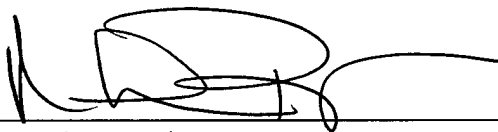
In the Advisory Action mailed July 24, 2003, the Examiner states that "claims 20 and 22 fail to further limit claims 5 and 13, respectively". Applicants note that new claim 24 (corresponding to previous claim 20) depends from claim 1, and is narrower in scope than both claim 1 and claim 5, as fewer types of reinforcing layers are claimed. New claim 26 (corresponding to previous claim 22) is narrower in scope than claim 13 for the same reason.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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